

REMARKS

I. Status of Claims

In the present Amendment, claims 3, 18, and 71 have been canceled without disclaimer and prejudice. Claims 1, 25, 28, 38, 39, 57, and 58 have been amended. Specifically, claims 1, 57, and 58 have been amended by incorporating into them certain elements recited in claim 18, such as the quaternary ammonium salts of formula XIV. Claims 25, 28, 38, and 39 have been amended to correct their dependencies. Therefore, Applicants have not introduced any new matter by the amendment, nor does the amendment raise new issues or necessitate the undertaking of any additional search of the art by the Office.

Claims 1, 25, 28, 38, 39, and 43-58 are pending and subject to examination in this application.

II. Rejections under 35 U.S.C. § 103

A. Claims 1, 3, 18, 25, 28, 38, 39, and 43-58

The Examiner has maintained the following rejections of claims 1, 3, 18, 25, 28, 38, 39, and 43-58 under 35 U.S.C. § 103 for the reasons of record:

(1) claims 1, 3, 18, 25, 28, 38, 39, and 43-58 over U.S. Patent No. 5,482,704 to Sweger et al. ("Sweger") in view of U.S. Patent No. 6,010,689 to Matsumoto et al. ("Matsumoto") and U.S. Patent No. 5,876,705 to Uchiyama et al. ("Uchiyama"); and

(2) claims 1, 3, 18, 25, 28, 38, 39, and 43-58 over U.S. Patent No. 4,954,335 to Janchipraponvej ("Janchipraponvej") in view of Sweger, Uchiyama, and U.S. Patent No. 6,210,689 to Martino et al. ("Martino") for the reasons of record. Office Action, pages 2-5.

Applicants respectfully traverse these rejections for the reasons of record and the following additional reasons.

Several basic factual inquiries must be made to determine whether the claims of a patent application are obvious under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), require the Examiner to:

- (1) determine the scope and content of the prior art;
- (2) ascertain the differences between the prior art and the claims in issue;
- (3) resolve the level of ordinary skill in the pertinent art; and
- (4) evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 USPQ 467; see also *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007) and M.P.E.P. § 2141. "[R]ejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." M.P.E.P. § 2142 (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)); see also *KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396 (quoting the Federal Circuit statement with approval).

Applicants maintain that in light of the above-cited guidance from the M.P.E.P., the Examiner has failed to satisfy the initial burden of establishing a *prima facie* case of obviousness. Specifically, the Examiner has provided "mere conclusory statements"

and has failed to articulate “reasoning with some rational underpinning” for why one of ordinary skill in the art would pick and choose the specific cationic conditioner as recited in, for example, the currently-amended claim 1, from all types of well-known hair care product ingredients. The specific cationic conditioner chosen from cationic silicones and quaternary ammonium salt surfactants chosen from quaternary ammonium salts of formula (XIV) and quaternary ammonium salts of imidazolinium of formula (XV) as recited in, for example, the currently-amended claim 1 is a subgenus of the cationic conditioner. The fact that a claimed subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness. M.P.E.P. § 2144.08 (citing *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994)). Therefore, the Examiner has not established a *prima facie* case of obviousness. Accordingly, this rejection is improper.

Moreover, as Applicants have discussed in detail on the record, the alleged combination of Janchipraponvej with Sweger by the Examiner would destroy the intended purpose of Janchipraponvej, which is to provide a clear composition. Indeed, incorporating the starch of Sweger into the composition of Janchipraponvej would destroy the composition’s lauded clarity. See Applicants’ November 10, 2004, Reply After Final; Applicants’ May 24, 2004, Reply to Office Action; Applicants’ December 1, 2003, Request for Reconsideration; and Mme. MAHE’s November 24, 2003, Rule 1.132 Declaration. The destruction of the composition’s clarity defeats an allegation of obviousness since it is known that “if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” M.P.E.P. § 2143.01 V.

Therefore, Applicants respectfully request these rejections be withdrawn.

B. Claim 71

The Examiner has also rejected claim 71 under 35 U.S.C. § 103 over Sweger, in view of Matsumoto and Uchiyama, and in further view of U.S. Patent No. 3,912,808 to Sokol ("Sokol") or over Janchipraponvej in view of Sweger, Matsumoto and Uchiyama, and in further view of Sokol for the reasons of record. Office Action, pages 5-6.

Applicants respectfully disagree. However, solely to advance the prosecution of this application, Applicants have canceled claim 71, rendering this rejection moot. Accordingly, Applicants respectfully request this rejection be withdrawn.

V. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

/Louis Troilo/

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By: _____
Louis M. Troilo
Reg. No. 45,284